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TRANSMITTAL OF APPEAL BRIEF (Large Entity)	Docket No. YOR920010540US1
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In Re Application Of: E. Yashchin, et al.						
<div style="border: 1px solid black; border-radius: 50%; width: 40px; height: 40px; display: flex; align-items: center; justify-content: center; margin: 0 auto;"> <div style="writing-mode: vertical-rl; transform: rotate(180deg); font-size: 8px;">RECEIVED</div> <div style="text-align: center;"> O I P E OCT 31 2005 </div> <div style="writing-mode: vertical-rl; font-size: 8px;">PATENT OFFICE</div> </div>	Application No. 10/040,474	Filing Date January 9, 2002	Examiner A. Baturay	Customer No. 30743	Group Art Unit 2155	Confirmation No. 2599

Invention: **SMART MESSENGER**

COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on
September 19, 2005

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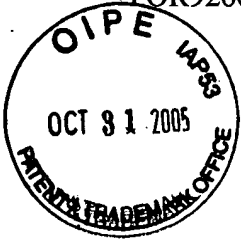

Signature

Dated: **October 31, 2005**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of

Emmanuel Yashchin et al.

Serial No.: 10/040,474

Filed: January 9, 2002

For: SMART MESSENGER

Confirmation No. 2599

Group Art Unit: 2155

Examiner: Alicia Baturay

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

APPELLANT'S BRIEF UNDER 37 C.F.R. §41.37

This brief, which is filed herewith in triplicate, is in furtherance of the Notice of Appeal, filed in this case on September 19, 2005.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. §41.37(c)):

I. REAL PARTY IN INTEREST

II. RELATED APPEALS AND INTERFERENCES

III. STATUS OF CLAIMS

IV. STATUS OF AMENDMENTS

V. SUMMARY OF CLAIMED SUBJECT MATTER

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

VII. ARGUMENTS

☐ ARGUMENT VIIA. REJECTIONS UNDER 35 U.S.C. §112, FIRST

11/01/2005 SZEWDIE1 00000134 500510 10040474

PARAGRAPH

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☐ ARGUMENT VIIB. REJECTIONS UNDER 35 U.S.C. §112, SECOND
PARAGRAPH

☐ ARGUMENT VIIC. REJECTIONS UNDER 35 U.S.C. §102

☒ ARGUMENT VIID. REJECTIONS UNDER 35 U.S.C. §103

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VIII. CLAIMS APPENDIX

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YOR920010540US1

I. REAL PARTY IN INTEREST

The real party in interest in the appeal is:

- ☐ the party named in the caption of this brief.
- ☒ the following party: International Business Machines Corp. of
Armonk, New York

II. RELATED APPEALS AND INTERFERENCES

With respect to other appeals, interferences or judicial proceedings that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal:

☒ there are no related appeals, interferences or judicial proceedings related to, which directly affect or may be directly affected by or have a bearing on the Board's decision in this pending Appeal.

☐ these are as follows:

III. STATUS OF CLAIMS

The status of the claims in this application are:

A. Total number of claims in Application are: claims 1 to 19

B. Status of all the claims:

1. Claims cancelled: claims 2 and 11
2. Claims withdrawn from consideration but not cancelled: n/a
3. Claims pending: claims 1, 3 to 10, 12 to 19
4. Claims allowed: none
5. Claims rejected: 1, 3 to 10, 12 to 19

B. Claims on Appeal.

The claims on appeal are: 1, 3 to 10, 12 to 19

IV. STATUS OF AMENDMENTS

The status of amendments filed subsequent to the final rejection are as follows:

An amendment under 37 C.F.R. §1.116, filed on July 28, 2005, in response to the final rejection mailed July 18, 2005, has been entered for purposes of this appeal, as indicated in the Advisory Action mailed on August 12, 2005. This amendment amended claims 1 and 8 to respectively incorporate the limitations of claims 2 and 11 and canceled claims 2 and 11.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter as defined in the claims on appeal is directed to a method and system for conducting messaging sessions in which an automated topic separator separates messages or parts of messages according to topic. The topic separator utilizes information from a time synchronizer to determine the topical relationship between messages. By implementing the present system and method, the present invention enables users to conduct smooth messaging sessions without interruption.

Independent claim 1 is drawn to a messaging system that requires:

- (1) an interactive system for production and interchange of messages by users over a network;
- (2) an automated topic separator receiving user messages and separating messages according to different topics, wherein the automated topic separator separates messages or parts of messages according to words used in the messages;
- (3) a user interface, coupled to said topic separator, for representing in a distinct way parts of messages that were separated by said topic separator; and
- (4) a time synchronizer for time stamping messages, the topic separator being responsive to said time synchronizer to determine topical relationships between messages.

The interactive system (1) is shown in Figure 1. The topic separator (2) is supported by the description of the specification in page 6, lines 6 to 28, and Figure 2.

Especially, the automated mechanism is explained in page 6, lines 17 to 28 of the specification. The user interface (3) is explained in page 7, lines 1 to 25 in conjunction with Figure 3, which illustrates the logic and presentation of the messenger graphic user interface (GUI). Page 6, lines 6 to 16, and Figure 2 explain

the time synchronizer, and that time stamping information is used to determine topical relationship between messages.

Independent claim 8 is drawn to a method of conducting a messaging session over a network that requires:

- (1) receiving a message over the network from a user;
- (2) automatically identifying a topic of the received message based on words used in the message;
- (3) determining if the topic of the received message has changed from a previous message;
- (4) identifying a time of a received message;
- (5) determining if a changed topic is a new topic using the time of the received message to determine whether the topic has changed or is a new topic;
- (6) determining if a changed topic is a new topic, and if a new topic, opening a new window to display the received message.

Figure 9 illustrates a flow diagram of the overall operation of the invention technology as claimed in claim 8. The process begins in function block [900], where a message is received through local means via a computer (the above step (1)). The topic of a message is identified in function block [901], and the time of a message is identified in function block [902]. Those function blocks support the above steps (2) and (4). In decision block [903], whether the topic has changed or not is determined (the step (3)). A determination is made in decision block [906] as to whether the topic is new (the step (5)), and if the topic is new, the system must create a new display window in function block [908] and display in the window in function block [909] (the step (6)).

The core of a system implemented according to the claimed subject matter is the interactive system, the topic separator, the user interface, which is coupled to the

topic separator, and the time synchronizer. Thus, the messaging system according to the claimed subject matter performs all the functions of a conventional messaging system having a topic selection and discrimination system. Here, the system claimed in the present invention further includes the following characteristics:

- * The topic separator is an automated topic separator which separates messages or parts of messages according to words used in the messages.

- * The topic separator is responsive to the time synchronizer to determine topical relationships between messages.

The claimed subject matter can be useful for two or more users in a messaging session to converse freely and naturally without interruption. Users of the present system do not have to stop to organize messages according to topic, or to identify for the computer messages that belong to particular topics since the topic identification and separation is provided automatically. In addition, note that in the present invention messages can be analyzed so that parts of messages are split according to topic. Thus, a long message comprising different topics can be split according to the topics.

In addition, information from the time synchronizer is used to determine which messages share a common topic so that the timing information helps the topic separator remove ambiguity when the topic of a message is not clear.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The final rejection mailed July 18, 2005, made the following rejections:

1. Claims 1–5, 8–12, and 16–19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,557,027 to Cragun in view of U.S. Patent No. 6,104,989 to Kanevsky et al.
2. Claims 7, 13 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,557,027 to Cragun in view of U.S. Patent No. 6,104,989 to Kanevsky et al. and U.S. Patent No. 6,016,476 to Maes et al.
3. Claims 6 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,557,027 to Cragun in view of U.S. Patent No. 6,104,989 to Kanevsky et al., U.S. Patent No. 6,016,476 to Maes et al. and U.S. Patent Publication No. 21001/0028364 to Fredell et al.

The amendment filed July 28, 2005, incorporated the limitations of claim 2 into claim 1 and incorporated the limitations of claim 11 into claim 8. Claims 2 and 11 were cancelled. The Advisory Action mailed August 12, 2005, entered the amendment filed July 28, 2005, for purposes of this Appeal. Therefore, the first ground of rejection is moot as to claims 2 and 11. However, the Examiner's comments indicated that the grounds for rejection remained the same.

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ARGUMENT VIIA. REJECTIONS UNDER 35 U.S.C. §112, FIRST PARAGRAPH

There are no rejections under 35 U.S.C. §112, first paragraph.

YOR920010540US1

ARGUMENT VIIB. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

There are no rejections under 35 U.S.C. §112, second paragraph.

YOR920010540US1

ARGUMENT VIIC. REJECTIONS UNDER 35 U.S.C. §102

There are no rejections under 35 U.S.C. §102.

ARGUMENT VIID. REJECTIONS UNDER 35 U.S.C. §103

1. Claims 1, 3–5, 8–10, 12, and 16–19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,557,027 to Cragun in view of U.S. Patent No. 6,104,989 to Kanevsky et al. The patent to Kanevsky et al. is cited on page 6, lines 20 and 21, and page 9, line 9, of the present application. Moreover, the two named inventors of the Kanevsky et al. patent, Demitri Kanevsky and Emmanuel Yashchi, are named inventors in the present application. Both the Cragun and Kanevsky et al. patents are assigned to the party in interest in this application.

As amended by the amendment filed July 28, 2005, all claims now require the feature of time stamping, and that a topic separator uses the time stamp information to determine topical relationships between messages. The claimed subject matter is directed to a method and system for conducting messaging sessions in which an automated topic separator separates messages or parts of messages according to topics. The time synchronizer puts a time stamp on every message sent by different users, and the time-stamped messages are associated with the topic splitter 207 (Figure 2). The topic splitter uses the information not only from the topic classifier 206 and the topic change detector 205, but also from the time synchronizer 208, as claimed. In the invention, the time stamp is used for relating one message of one user to another message of another user. Since the topic separator utilizes the time stamp on messages to determine which messages share a common topic, the information helps the topic separator remove ambiguity when the topic of a message is not clear. As discussed on page 6, lines 27 to 28 of the application, “For example, if two messages are sent at different times but seem to have a mild relationship they are probably not related.” Hence, if a topic separator was used without reference to the time synchronizer contemplated by this invention, unrelated messages may be incorrectly grouped together.

Cragun teaches a system and method for managing online discussions in which messages are manually sorted according to topic. Time stamping is not used in Cragun, as has been acknowledged by the Examiner. Specifically, Cragun teaches that users select and discriminate messages according to topic.

Further, Kanevsky et al. in col. 4, lines 53 to 54, state that “once the change in topic is detected, establish the time of onset of the new topic...”. This means Kanevsky et al. teach only that the time of a change of topic is detected and stored. Kanevsky et al. use the time of change of topic for keeping records. Kanevsky et al. do not show or discuss having a topic separator that is responsive to time stamping by a time synchronizer. As is discussed on page 6, lines 19 to 23, of the application, the Kanevsky et al. topic time change mechanism might be used as element 205 in the claimed subject matter (see Figure 2).

The combination of Cragun and Kanevsky et al. does not make the invention obvious because, as discussed above, Kanevsky et al. does not teach what the Examiner says. If Cragun is combined with Kanevsky et al., the combination would merely work in such a way that when a user selects a message according a topic because the topic is changed from a previous one, the time when the user selected the message is detected. With reference to Figure 2 of the application, the combination would only yield part of the left side arm (element 205), and would not make obvious the right side arm (synchronizer 207). Thus, the combination would only sort according to the Cragun technique.

Furthermore, one ordinary skill in the art would not combine Cragun with Kanevsky et al. Unlike Cragun, Kanevsky et al. utilize training data, which is an essential feature in Kanevsky et al. The training data comprises large blocks of text identified as to topic. The training data is used to teach the software proper identification of words and topics so that accuracy is improved. Training data must be grouped according to a finite number of predetermined topics. This limitation is

incompatible with the claimed subject matter because the claimed subject matter is directed to real-time messaging sessions and it is not possible to identify all possible topics beforehand. Cragun, in contrast to Kanevsky et al., does not require training data. Rather, Cragun teaches topic identification and separation manually by the operator or an administrator. See, for example, the following passages in Cragun:

- col. 4, lines 4–7: “features that enable the meeting's participants to direct comments toward particular sub-topics, to view comments according to sub-topic, and to reassign comments from one sub-topic to another”
- col. 4, lines 17–20: “the ability to reassign messages may be granted only to a predetermined meeting leader, or that ability may be granted only to the person who sent the message or to both the meeting leader and the message sender”
- col. 5, lines 53–55: “Main application window 510 also provides a sub-topic input field 580 and a sub-topic creation button 582 for creating new subtopics with operator-specified titles.”
- col. 6, lines 38–40: “since entered message are associated with sub-topics, the control codes also include a sub-topic identifier”
- col. 9, lines 9–11: “Chat client program 260 then determines whether the operator associated the new message with a new sub-topic”

In his final rejection, the Examiner states with respect to claim 1 that “Cragun does not *explicitly* teach the use of an automatic message topic separator” (emphasis added). The use of the adverb “explicitly” is misleading and would seem to suggest that there may be some *implicit* teaching in Cragun of an automatic message topic separator, but as clearly demonstrated by the above citations, Cragun actually teaches away for an automatic message topic separator. Similarly, with respect to claim 8, the Examiner states that “Cragun does not *explicitly* teach automatically identifying a topic” (emphasis added), but again it is clear that Cragun teach away from automatic

identification of topics.

With respect to claim 2, the limitations of which are now incorporated into claim 1, the Examiner states that “Cragun teaches the invention in claim 1, including the messaging system further comprising a time synchronizer for time stamping messages (Cragun, col. 6, lines 54–60).” While Cragun does describe posting a time-stamp control code, the Examiner wrongly alleges that Cragun teaches a time synchronizer as claimed. Cragun merely teaches that a sub-topic post can include a time stamp for each message. Therefore, Cragun does not teach or suggest that a time stamp can be used to determine whether the topic has changed or is a new topic, as required by claims 1 and 8. Cragun relies on users to explicitly specify topics and sub-topics and does not teach that the computer can automatically determine whether a topic has changed or not.

2. Claims 7, 13, and 15 stand rejected under 35 U.S.C. §103 (a), as being unpatentable over U.S. Patent No. 6,557,027 to Cragun in view of U.S. Patent No. 6,104,989 to Kanevsky et al. and further in view of U.S. Patent No. 6,016,476 to Maes et al.

As argued above, Cragun’s system requires that users select and discriminate messages according to topic, and Kanevsky et al. solely teach the time of a change of topic is detected and stored. Therefore, a person skilled in the art would not combine them to reach the claimed subject matter as claimed in claims 1 and 8. Here, claim 7 is dependent on claim 5 which, in turn, is dependent on claim 1, and claims 13 and 15 are dependent on claim 12 which, in turn, is dependent on claim 8. Claim 7 adds that the security system recited in claim 5 includes a biometric module for verification of a user’s identity. Claim 13 adds that the step of checking the user’s identity recited in claim 12 comprises the steps of asking the user random questions and evaluating the user’s answers. Claim 15 adds that the step of checking the user’s identity recited in claim 12 is performed using biometrics.

Maes et al. does not make up for deficiencies of the combination of Cragun and Kanevsky et al. The Maes et al. technology concerns portable information and transaction processing system such as a personal digital assistant (PDA), which employs a security system using a biometric. It should also be noted that the field of technology of Maes et al. is totally different from that of the claimed subject matter and, for that matter, that of Cragun and Kanevsky et al. It is therefore not possible for a person skilled in the art to refer to Maes et al. to arrive at the claimed subject matter. The patent to Maes et al. has been merely cited only for its use of a biometric. It should be noted that the combination would not be obvious to one of ordinary skill in the art, and the combination represents an impermissible hindsight reconstruction of the invention.

A combination of Cragun, Kanevsky et al. and Maes et al. would yield a device which sorts topics in the manner of Cragun since neither Kanevsky et al. nor Maes et al. shows or suggests an alternative sorting mechanism which employs time stamping with a security system using either random questions or a biometric.

3. Claims 6 and 14 stand rejected under 35 U.S.C. §103 (a), as being unpatentable over U.S. Patent No. 6,557,027 to Cragun in view of U.S. Patent No. 6,104,989 to Kanevsky et al., U.S. Patent No. 6,016,476 to Maes et al., and U.S. Patent Publication No. 2001/0028364 to Fredell et al.

To summarize the above discussion again, Cragun's system requires users select and discriminate messages according to topic, Kanevsky et al. solely teach the time of a change of topic is detected and stored, and field of technology of Maes et al. is totally irrelevant to the claimed subject matter and the combination of Cragun and Kanevsky et al. Therefore, a person skilled in the art would not combine them to reach the claimed subject matter as recited in claims 1 and 8. Here, claim 6 is dependent on claim 5 which, in turn, is dependent on 1, and claim 14 is dependent on claim 13 which, in turn, is dependent on claim 8.

Claims 6 and 14 require that the identity of a user is authenticated by other users of the system, and that other users verify the answers provided by the user being authenticated. In this way, it becomes the choice of a user whether or not to accept the given authentication attempt of another user. Therefore, the user can determine the importance of proper authentication. In contrast, Fredell et al. teach a completely different concept. Fredell et al. teach a method for storing and distributing contact information such as phone number, e-mail, fax number, and so on. Specifically, Fredell et al. disclose “online user directory that is accessible to all project participants”. In this way, all users can access to the contact information of other participant. This is very different from the claimed subject matter. The security measure taught by Fredell et al. are well known, conventional methods employing passwords and so on, for user identity verification. Also, noted that the verification by Fredell et al. is also performed by the computer. Fredell et al. does not teach or suggest “user to user authentication” as required in claims 6 and 14.

A combination of Cragun, Kanevsky et al., Maes et al. and Fredell et al. would yield a device which sorts in the manner of Cragun since none of Kanevsky et al., Maes et al., nor Fredell et al. shows or suggests an alternative sorting mechanism which employs time stamping with a security system in which a use’s identity is verified by another user.

ARGUMENT VIIIE. REJECTION OTHER THAN 35 U.S.C. §§102, 103 AND 112

There are no rejections other than the rejections under 35 U.S.C. §103.

VIII. CLAIMS APPENDIX

The text of the claims involved in the appeal are:

- 1 1. A messaging system comprising:
2 an interactive system for production and interchange of messages by
3 users over a network;
4 an automated topic separator receiving user messages and separating
5 messages according to different topics, wherein the automated topic separator
6 separates messages or parts of messages according to words used in the
7 messages; and
8 a user interface, coupled to said topic separator, for representing in a
9 distinct way parts of messages that were separated by said topic separator ; and
10 a time synchronizer for time stamping messages, the topic separator
11 being responsive to said time synchronizer to determine topical relationships
12 between messages.
- 1 3. The messaging system as in claim 1, wherein said user interface displays
2 messages in windows according to topic.
- 1 4. The messaging system as in claim 1, wherein said user interface displays
2 messages in different colors according to topic.
- 1 5. The messaging system as in claim 1, further comprising a security system
2 to verify a user's identity.
- 1 6. The messaging system as in claim 5, wherein said security system includes
2 a database of questions from which random questions are posed to a user and

3 whereby verification of validity of answers to posed questions is done by users
4 of the system.

1 7. The messaging system as in claim 5, wherein said security system includes
2 a biometric module for verification of a user's identity.

1 8. A method of conducting a messaging session at a user's computer between
2 two or more users over a network comprising the steps of:
3 receiving a message over the network from a user;
4 automatically identifying a topic of the received message based on
5 words used in the message;
6 determining if the topic of the received message has changed from a
7 previous message;
8 identifying a time of a received message;
9 determining if a changed topic is a new topic using the time of the
10 received message to determine whether the topic has changed or is a new
11 topic;
12 determining if a changed topic is a new topic; and
13 if a new topic, opening a new window to display the received message.

1 9. The method of conducting a messaging session recited in claim 8, wherein
2 if the topic of a received message has not changed, further comprising the step
3 of displaying the received message in a currently opened window.

1 10. The method of conducting a messaging session recited in claim 8,
2 wherein if a changed topic is not a new topic, further comprising the step of
3 displaying the received message in a previously opened window.

1 12. The method of conducting a messaging session recited in claim 8, further
2 comprising the step of checking a user's identity.

1 13. The method of conducting a messaging session recited in claim 12,
2 wherein the step of checking a user's identity comprises the steps of asking the
3 user random questions and evaluating the user's answers.

1 14. The method of conducting a messaging session recited in claim 13,
2 wherein the step of evaluating the user's answers is performed by another user.

1 15. The method of conducting a messaging session recited in claim 12,
2 wherein the step of checking a user's identity is performed using biometrics.

1 16. The messaging system as in claim 1, wherein the messaging system
2 enables a subgroup of users to conduct a messaging session separately from
3 other users of the messaging system.

1 17. The method of conducting a messaging session recited in claim 8,
2 wherein a subgroup of users comprising at least two users conducts a
3 messaging session separately from other users.

1 18. The messaging system as in claim 1, wherein the automated topic
2 separator is operable for indicating to the user when the topic of a message can
3 not be decided by the topic separator.

- 1 19. The method of conducting a messaging session recited in claim 8,
- 2 wherein the topic of the received message can not be decided, and further
- 3 comprising the step of indicating to the user that the topic of the received
- 4 message could not be decided.

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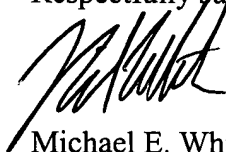
IX. EVIDENCE APPENDIX

There is no additional evidence submitted under 37 C.F.R. §§1.130, 1.131 or 1.132 or any other evidence to be considered in this appeal.

X. RELATED PROCEEDINGS APPENDIX

There are no related appeals, interferences or judicial proceedings related to, which directly affect or may be directly affected by or have a bearing on the Board's decision in this pending Appeal.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Whitham", is written over the typed name.

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